RESPONSE AND REMARKS

Amendments to Claims 1 through 57 are filed concurrently herewith to more distinctly claim the invention. New Claim 58 is filed concurrently herewith. Entry of the amendments to Claims 1 through 57 and new Claim 58, and reconsideration of the application, as amended, are respectfully requested.

SPECIFICATION

In the Office action, the Examiner objected to use of various trademarks as used in the specification and indicated that the trademarks should be capitalized wherever they appear. Responsive to the Examiner's objections to the use of trademarks, the specification, as amended, identifies trademarks used in the specification, references the proprietary nature of those trademarks through the use of the "TM" symbol, and equates the TM-designated trademark with both an all-capitalized version of the trademark and with alternative ways in which the trademarks appear in the specification.

CLAIM OBJECTIONS

In the Office Action, the Examiner objected to the numbering of the Claims, noting that Claim 32 had been missing from the original claims. The Examiner renumbered original Claims 33 through 58 as Claims 32 through 57 respectively, and suggested that the dependencies of renumbered Claims 32 through 57 be amended to reflect the renumbering. The claim amendments filed concurrently herewith reflect the claim renumbering and claim dependency renumbering.

SECTION 112

In the Office Action, the Examiner rejected Claims 1-57 as being indefinite under 35 U.S.C. §112 on several grounds. The Examiner rejected Claims 1, 4-8, 10, 13-17, 19, 22-26, 28, 31-35, 38-42, 45-50, 52, 54, 55 and 57, concluding that there was insufficient antecedent basis for the claimed term "user client computer

device." Amendments to the rejected claims have been made to more specifically recite antecedent basis for the claimed term "user client computer device."

In the Office Action, the Examiner objected to the term "each of a plurality of users" in Claims 1, 7, 10, 16, 19, 25, 28, 34, 35, 41, 42, 48 through 50, 52, 54, 55, and 57, as indefinite. Amendments to the rejected claims recite "each respective user of a plurality of users."

In the Office Action, the Examiner objected to the term "each of a plurality of carriers" in Claims 1, 8, 10, 17, 19, 26, 28, 35, 42, 49, 52, and 55, as indefinite. Amendments to the rejected claims recite "each carrier of a plurality of carriers."

In the Office Action, the Examiner objected to the term "each of a plurality of services" in Claims 4, 8, 13, 17, 22, 26, 31, 38, and 45, as indefinite. Amendments to the rejected claims recite "each service of a plurality of services."

In the Office Action, the Examiner objected to the punctuation of Claims 2 through 6, 8, 9, 11-15, 17, 18, 20 through 24, 26, 27, 29 through 33, 36 through 40, and 43 through 47, and suggested alternative punctuation. Amendments to the rejected claims incorporate additional punctuation.

In the Office Action, the Examiner objected to the term "the particular user" in Claims 7, 16, 25, 34, 41, 48, 50, 54, and 57, as having insufficient antecedent basis. The rejected claims have been amended to recite "the respective user".

SECTION 101

In the Office Action, the Examiner rejected Claims 1 through 18, 28 through 41, and 49 through 54 under 35 U.S.C. §101. In rejecting these claims under Section 101, the Examiner read the claims as "not require[ing] the use of the computer system" but as "mere[ly] recit[ing]" . . . "technological arts . . . in the preamble." The Examiner concluded that the preamble of the rejected claims provided a "mere implication of employing a machine or article of manufacture to perform some or all of the recited steps" and that the rejected claims are "directed to non-statutory subject matter."

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It is respectfully submitted that because reference in the preamble of each of Claims 1 through 18, 28 through 41, and 49 through 54 to "a . . . . computer system" provides antecedent basis for subsequent reference to "*the* computer system" in each of Claims 1 through 18, 28 through 41, and 49 through 54, those claims are properly directed to statutory subject matter under Section 101. In particular, the preamble of each of Claims 1 through 18, 28 through 41, and 49 through 54 recites, or is dependent on a claim that recites, "a . . . computer system"; the body of the rejected claims (or a claim on which the subject claim is dependent) use as antecedent basis, recitation of "a . . . computer system" in the preamble. For example, the preamble of Claim 1(as amended) recites "A . . . computer system"; the body of Claim 1 recites . . . "wherein each respective user accesses *the* computer system . . . ". (Emphasis added).

It is respectfully submitted that the preamble of a claim, such as the preamble of Claims 1 through 18, 28 through 41, and 49 through 54, that recites matter that breathes life into the claim should not be discounted as a mere recitation of technological arts. See *Stranco Inc. v. Atlantes Chemical Systems Inc.*, 15 U.S.P.Q.2d 1704, 1713 (S.D. Tex. 1990) ("The fact that a preamble is necessary to provide antecedent basis for subsequent language in the claim is significant in determining that the preamble is a claim limitation."); s*ee also, Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997) ("Where a patentee uses the claim preamble to recite structural limitations of his claimed invention, the PTO and courts give effect to that usage. . . . "). In the present case, because the preamble of Claims 1 through 18, 28 through 41, and 49 through 54 provides antecedent basis for subsequent language of the claims, the claim preamble of each respective claim is properly taken into account when interpreting each claim.

Taking the preamble of each respective claim into account, it is respectfully submitted that Claims 1 through 18, 28 through 41, and 49 through 54 are directed to statutory subject matter under 35 U.S.C. § 101 because they are expressly directed to a computer system (Claims 1 through 9, 28 through 35, and 50 through 52), or a method using a computer system (Claims 10 through

18, 36 through 41, and 53 through 54), or a computer program product for execution by a computer system (Claims 19 and 49).

Further, as the Examiner agrees, Claims 1 through 18, 28 through 41, and 49 through 54, are directed to a practical application in the technological arts, the purpose of which is to produce a real world useful result, namely, *e.g.,* "calculated rates for carriers used in selecting a specific service for shipping...". Office Action, page 6, topic number 19. Therefore, Claims 1 through 18, 28 through 41, and 49 through 54 are directed to statutory subject matter under 35 U.S.C. §101. *See, e.g.,* State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 1373 (Fed. Cir. 1998) (citations omitted) ("Congress intended §101 to extend to 'anything under the sun that is made by man.'"); *id.* at 1372 ("The plain and unambiguous meaning of §101 is that any invention falling within one of the four stated categories of statutory subject matter may be patented, provided it meets the other requirements for patentability set forth in Title 35, i.e., those found in §§102, 103 and 112, P.2, n. 2."); MPEP §2106 II, A (the "purpose of this [section 101] requirement is to limit patent protection to inventions that possess a level of 'real world' value, as opposed to subject matter that represents nothing more than an idea or concept."); *id.* ("[Patent] Office personnel have the burden to establish a prima facie case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101.").

Further, the claims rejected under section 101 have been amended to expressly recite that the claimed computer system comprises at least one computer device.

For the above reasons and authorities, it is respectfully submitted that Claims 1 through 18, 28 through 41, and 49 through 54, as amended, are directed to statutory subject matter under 35 U.S.C. § 101; it is respectfully requested that Claims 1 through 18, 28 through 41, and 49 through 54, as amended, be reconsidered.

SECTION 103

In the Office Action, the Examiner rejected Claims 1-27 and 49-57 under section 103(a) as being unpatentable over Nicholls et al. (U.S. Patent No. 5,485,369; "*Nicholls*") in view of Fisher et al. (U.S. Patent No. 6,047,264; "*Fisher*") and Kara et al. (U.S. Patent No. 6,233,568; "*Kara*").

The Examiner rejected Claims 28-48 under section 103(a) as being unpatentable over *Nicholls* in view of Pauly et al. (U.S. Patent No. 4,958,280; "*Pauly*") and *Kara*.

It is respectfully submitted that the Claims, as amended, are patentably distinct from the cited references, alone or in combination. It is respectfully submitted that the cited references do not disclose, anticipate, or suggest, alone or in combination with any other cited reference, the subject matter of the amended claims of the present application that are directed to a simultaneous identification of, a display of, or a calculation or identification of charges by, respective carriers of a plurality of carriers that would provide delivery notification services or other service options, wherein the respective simultaneous identification, display or the calculation or identification is responsive to a request by a respective user of a plurality of users and is communicated to the respective user via a global communications network, such as the Internet.

In support of the rejection of Claims 1, 4, 6-10, 13, 15-19, 22, 24-27, 49-50, 52, 54, 55, and 57, the Examiner cited Figure 4A of *Nicholls* to support the proposition that "Nicholls discloses the [sic] rates are calculated for carriers with specific delivery requirements such as Proof of Delivery." The Examiner stated that *Nicholls* "fails to disclose the proof of delivery is an electronic mail delivery notification." However, the Examiner reasoned that *Fisher* "discloses a method for supplying automatic status updates using e-mail." The Examiner then concluded that "[I]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the electronic notification system, as disclosed by Fisher, in order to automatically *send* delivery status messages over e-mail . . ." (emphasis added).

Fisher discloses composing email messages to particular customers regarding the status of their respective orders according to the results of an interrogation by the *Fisher* system of respective carrier systems to determine the shipping status of the respective order by the respective carrier. *See Fisher*, col. 2, lines 12-18.

As distinguished from *Fisher*, none of the claims of the present application are directed to *sending* delivery status messages. Rather, as compared to the carrier-system-interrogation/email-generation approach taken by *Fisher*, the claims of the present application are directed to a simultaneous identification of, a display of, or a calculation of charges by, respective carriers that would provide delivery notification services. For example, Independent Claim 1 is directed to a simultaneous *identification* of carriers that would provide electronic delivery notification for delivery of a particular package. That is, in response to a request by a user of the claimed shipping management system for an electronic mail delivery notification service for shipping a respective particular parcel, the claimed shipping management system will display to the requesting user a simultaneous identification of the carriers that would provide electronic mail delivery notification.

Independent Claims 10, 19, 28, 35, 42, 49, 52, and 55 are similarly directed to a simultaneous identification of carriers that would provide a particular type of delivery notification, a plurality of service options, or a plurality of delivery notification services. Other claims, such as, *e.g.,* Independent Claims 7, 16, 25, 34, 41, 48, 51, 54, and 57 are directed to an identification of a service charge by each carrier that would support a particular delivery notification service, or a service charge for each delivery notification service supported by each carrier, for delivering a particular respective parcel.

New Claim 58 is also patentably distinct from *Nicholls*, whether taken alone or in combination with the other references of record. New Claim 58 recites:

> (F) *simultaneously displaying* on a display screen associated with said user:

(1) a first shipping charge that said first carrier would charge in conjunction with performing said at least one delivery service, said first shipping charge calculated to include said first service charge, and

(2) a second shipping charge that said second carrier would charge in conjunction with performing said at least one delivery service, said second shipping charge calculated to include said second service charge.

(Emphasis added). As compared to new Claim 58, there is no disclosure in *Nicholls* of a simultaneous display of shipping rates for multiple carriers wherein the shipping rate calculation includes calculation of a service charge for electronic mail delivery notification services.

Further, the disclosure in Figure 4A of *Nicholls* of "Proof of Del." under a "Special Services" title for a particular "Shipper" does not disclose, anticipate, or suggest, alone or in combination with any other cited reference, a simultaneous identification of, a display of, or a calculation of charges by, each carrier of a plurality of carriers that would provide delivery notification services or other service options.

Notably, Proof of Delivery is different than notification of delivery. A Proof of Delivery may comprise, *e.g.,* in the case of certified mail by the United State Postal Service (USPS), a scan at the point of delivery of the relevant parcel.

Certified USPS delivery, without a Return Receipt, does not result in any notification to the shipping user of delivery. Rather, the shipping user must query the USPS website to determine whether or not the parcel was certified as delivered.

As compared to a Proof of Delivery, a delivery notification sends, *e.g.,* via email or via some other method of communication, a notification to the shipping user that the relevant parcel has been delivered.

Further, as the Examiner correctly observes, *Nicholls* "fails to disclose displaying the rates of the carriers to the user." The Examiner then cites Figure 8, and column 22, lines 20-38 of *Kara* as disclosing "a computer program used for multiple shippers that displays that calculate [sic] shipping rates of multiple

carriers for multiple services." However, _Kara_ does not disclose, anticipate, or suggest, alone or in combination with any other cited reference, a simultaneous identification of, a display of, or a calculation of delivery notification or service option charges by, respective carriers that would provide delivery notification services or other service options.

As distinguished from the claims of the present application, there is no disclosure in _Kara_ regarding user input or selection of any type of delivery notification or other service options. As distinguished from delivery notification or other service options, _Kara_'s Figure 8 does disclose a portion of a display window (element 807) that would allow a user to designate a particular type of service, _e.g._, Overnight, or Same Day, or Next Day, or 2-Day, or 3-Day, or indicate that urgency is immaterial. In _Kara_'s Figure 8, the Overnight box has been selected. _Kara_'s Figure 8 also discloses a portion of a display window (element 808) that provides fields for dollar amounts for each of various carriers.

As compared to providing a simultaneous identification of, displaying, or calculating charges by, respective carriers that would provide delivery notification services or other service options, in _Kara_, the "program automatically calculates the [shipping] fees for each shipping service provider offering service commensurate with the desired shipping and/or delivery parameters." _Kara_, col. 22, lines 39 – 42. That is, once the user indicates a type of service (_e.g._, Overnight, or Same Day, or Next Day, or 2-Day, or 3-Day), the _Kara_ program calculates the shipping rate for each carrier that supports that type of service; only one rate per carrier is calculated. There is no disclosure in _Kara_ that the calculation of a rate for a carrier incorporates charges for delivery notification services or for other service options.

Accordingly, it is respectfully submitted that _Kara_ does not disclose, anticipate, or suggest, alone or in combination with any other cited reference, the subject matter of the amended claims of the present application that are directed to a simultaneous identification of, a display of, or a calculation of delivery notification or service option charges by, respective carriers of a plurality of carriers that would provide delivery notification services or other service options,

wherein the respective simultaneous identification, display or the calculation is responsive to a request by a respective user of a plurality of users and is communicated to the respective user via a global communications network, such as the Internet.

New Claim 58 is also patentably distinct from *Kara*, whether taken alone or in combination with the other references of record. New Claim 58 recites:

> (F) *simultaneously displaying* on a display screen associated with said user:
>
> > (1) a first shipping charge that said first carrier would charge in conjunction with performing said at least one delivery service, said first shipping charge calculated *to include said first service charge*, and
> >
> > (2) a second shipping charge that said second carrier would charge in conjunction with performing said at least one delivery service, said second shipping charge calculated *to include said second service charge*.

(Emphasis added). As compared to new Claim 58, there is no disclosure in *Kara* of a calculation of a shipping rate for a carrier that includes a calculation of a service charge for electronic mail delivery notification services.

In support of the rejection of Claims 28 through 48, the Examiner admitted that *Nicholls* "fails to specifically disclose the proof of delivery is a verbal delivery notification." The Examiner then cited *Pauley* to support disclosure of "the use of costumer [sic] service representatives which provide verbal communication of delivery status (Column 9, lines 34-38). . . ." and concluded that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the notification by the customer service representative, as disclosed by Pauley, in order to allow users to obtain delivery information without the use of a computer."

As distinguished from *Pauley*, none of the claims of the present application are directed to *providing* verbal delivery status messages. Rather, as compared to *Pauley*, the claims of the present application are directed to a simultaneous identification of, a display of, or a calculation of charges by,

respective carriers that would provide verbal delivery notification services. For example, Independent Claim 28 is directed to a simultaneous *identification* of carriers that would provide verbal delivery notification for delivery of a particular package. That is, in response to a request by a user of the claimed shipping management system for a verbal delivery notification service for shipping a respective particular parcel, the claimed shipping management system will display to the requesting user a simultaneous identification of the carriers that would provide verbal delivery notification.
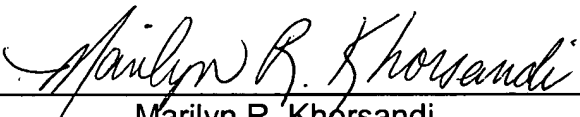
Accordingly, it is respectfully submitted that *Pauley,* alone or in combination with any other cited reference, does not disclose, anticipate, or suggest, the subject matter of the amended claims of the present application that are directed to a simultaneous identification of, a display of, or a calculation of charges by, respective carriers of a plurality of carriers that would provide verbal delivery notification services, wherein the respective simultaneous identification, display or the calculation is responsive to a request by a respective user of a plurality of users and is communicated to the respective user via a global communications network, such as the Internet.

For the foregoing reasons and authorities, because independent Claims 1, 7, 8, 10, 16, 17, 19, 25, 26, 28, 34, 35, 41, 42, 48, 49, 50, and 51 through 57 (as amended), and new Claim 58 are patentable over the cited references, Applicant respectfully submits that dependent Claims 2 through 6, 9, 11 through 15, 18, 20 through 24, 27, 29 through 33, 36 through 40, and 43 through 47, are therefore also patentable over the cited references.

In view of the foregoing amendments, and for the foregoing reasons and authorities, Applicant respectfully submits that the invention disclosed and claimed in the present amended application is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and allowance of the amended application.

Respectfully submitted,

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